

REMARKS

The Examiner is thanked for the performance of a thorough search. By this response, Claims 1-3, 7, 25, 30, 33, 37, 38, 60, 65, 72, 73, 74, 76, 84, 85, 87-89, 98, 101, 116 have been amended. Claims 15, 18, 29, 32, 50, 53, 64, 67, 75, 86, 96, 99, 118, 120-123 have been canceled. Claims 124-156 are added. Hence, Claims 1-4, 6-9, 11, 12, 16, 25, 30, 31, 33, 36-39, 41-44, 46, 47, 51, 60, 65, 66, 68, 71-74, 76, 77, 84, 85, 87-89, 97, 98, 100, 101, 116, 117, 119, and 124-156 are pending in this application.

All issues raised in the final Office Action mailed June 8, 2010 are addressed hereinafter.

I. ADDED CLAIMS / AMENDMENTS

The added claims and amendments to the claims do not add any new matter to this application and are supported by the Specification as originally filed. The amendments to the claims, which may broaden certain aspects of the original claims, improve the readability and clarity of the claims. Furthermore, added Claims 124-156 are patentable over the cited references for at least the same reasons as Claims 1, 38, or 116, upon which they depend or to which they recite similar features.

The canceled claims were canceled solely in the interest of expediting prosecution as to the pending claims, and not for any reason related to the merits of the cited references.

II. CLAIM OBJECTIONS

Claim 98 stands under objection for depending upon a canceled claim. Claim 98 has been amended to depend from Claim 1. Therefore the objection is fully addressed. Reconsideration of the objection is requested.

Claims 120-123 stand under objection under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. These claims are canceled. Therefore the objection is moot. Reconsideration of the objection is requested.

III. CLAIM REJECTIONS BASED ON 35 U.S.C. § 112

Claims 1 and 38 and their dependents (claims 1-4, 6-9, 11, 15, 16, 18, 25, 29-33, 36-39, 41-44, 46, 47, 50, 51, 53, 60, 64-68, 71-77, 84-89 and 96, 98, 99, 101) stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed. However, the feature at issue has been deleted from the claims, thereby rendering the rejection moot. Removal of the rejection is requested.

IV. CLAIM REJECTIONS BASED ON 35 U.S.C. § 103

A. **Mehta and Leveridge.**

Claims 1-4, 6, 8, 9, 11, 15, 16, 18, 31-33, 36-39, 41, 43, 44, 46, 50, 51, 53, 66-68, 71-73, 75, 77, 84, 86, 88, 89, 96, 98, 99, 101 and 116-123 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Publication No. 2002/0131404 (hereinafter *Mehta*) in view of WO 99/31610 (hereinafter *Leveridge*). This rejection is respectfully traversed.

CLAIM 1

Claim 1 presently recites, among other features:

based at least on the intercepted message, software
managed by the third party performing the steps of:

... before the content is delivered to the requestor:
determining whether the requestor is required to
pre-authorize payment for the content;
in response to the determining that the requestor is
required to pre-authorize payment for the
content, sending the requestor a payment
authorization request message;
in response to detecting that the requestor has
authorized payment for the content,
retransmitting the message to allow the
requestor to obtain the content;

The cited references do not, and are not alleged to, teach or suggest these features. However, the Office Action has alleged that U.S. Patent No. 6,704,612 (hereinafter *Hahn*) describes similar features that were previously recited in Claim 29. The Office Action is mistaken.

Hahn describes “a computer processing system for a shipment transaction involving a shipper and carrier.” *Hahn* at abstract. The system automates the payment of a shipment transaction by billing the shipper and crediting the carrier upon receiving proof of delivery. *Id.* The Office Action alleges that *Hahn* describes features similar to those recited above in col. 11, line 45 – col. 12, line 5. However, the relied upon passage merely describes how the central processor 40 **sends an authorization request to an issuing institution (e.g. a bank)** before allowing shipment. The relied upon passage includes no description of “sending **the requestor** a payment authorization request message” as recited in Claim 1. The issuing institution is not a requestor of anything, so the request sent to the issuing institution cannot possibly be the claimed payment authorization that is sent to the requestor.

Moreover, the analogy that the Office Action attempts to establish between *Hahn* and Applicants’ claims is flawed. **Claim 1 recites behavior performed by a device that intercepts messages requesting or containing contents** for which pre-authorization is required. *Hahn* describes behavior performed by a **central processor 40 that never has the opportunity to intercept, or is even capable of intercepting, the physical shipments it authorizes**. *Hahn*’s central processor 40 is clearly not similar to the

“intercepting device” recited in Claim 1, and as such would not teach or suggest to one skilled in the art any modifications to such an “intercepting device.”

For at least the foregoing reasons, the cited references fail to provide the complete subject matter recited in independent Claim 1. Therefore, the cited references would not have rendered Claim 1 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

CLAIM 116

Claim 116 recites, among other elements:

intercepting a **message** that has been **sent from a provider to a requestor**, prior to said message being received by the requestor;

...
wherein the **message includes a price at which the provider is willing to provide content included in the message**;

based at least on the intercepted message, software managed by the third party performing the steps of:
reading the price from the message;
sending billing data to a billing service, the **billing data being based on the price that was extracted from the message by the software managed by the third party**;

The cited references fail to teach or suggest the method of Claim 116 for at least the reason that the cited references fail to teach or suggest a “message . . . sent . . . to a requestor . . . [that] includes a price at which the provider is willing to provide content included in the message” and “billing data being based on the price that was extracted from the message by the software managed by the third party.” The Office Action alleges that *Mehta* at ¶ [0098] describes similar features that were previously recited in Claim 11. The Office Action is mistaken.

Mehta at ¶ [0098] describes how an application provider informs a Mobile Application System (MAS)—the alleged intercepting device—of a price for an

application—the alleged “content.” Specifically, the application provider communicates this information to the MAS via interaction with a website after an application has been submitted to the MAS for approval. *Id.* As *Mehta* explains “once the application has been . . . inspected for submission, the content provider website preferably requests additional information” including “suggested sales price.” *Id.* The MAS subsequently uses this pricing information to bill users who download the application from or via the MAS.

Rather than including the price **in a message to the requestor that includes the content being priced**, as recited in Claim 116, *Mehta* describes **the communication of pricing information in a message that is entirely separate from the alleged content**. In fact, the pricing information is clearly sent after, and not in, the messages that communicate the alleged content. Moreover, the message that includes the pricing information in *Mehta* **is not even addressed to the requestor** of the alleged content, but is instead addressed to the alleged third-party (the MAS itself). Thus, *Mehta* clearly does not teach or suggest “intercepting a message that has been sent from a provider to a requestor, . . . wherein the message includes a price at which the provider is willing to provide content included in the message” as recited in Claim 116. Since *Mehta* does not teach such a message, *Mehta* furthermore cannot teach or suggest “billing data being based on the price that was extracted from the message by the software managed by the third party” as recited in Claim 116.

For at least the foregoing reasons, the cited references fail to provide the complete subject matter recited in independent Claim 116. Therefore, the cited references would not have rendered Claim 116 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

CLAIM 38

Independent Claim 38 also recites features discussed above with relation to Claim 1, although Claim 38 is expressed in another format. Therefore, Claim 38 is allowable

over the cited references for at least one of the same reasons as given above for Claim 1. Reconsideration is respectfully requested.

DEPENDENT CLAIMS 2-4, 6, 8, 9, 11, 15, 16, 18, 31-33, 36-37, 39, 41, 43, 44, 46, 50, 51, 53, 56-68, 71-73, 75, 77, 84, 86, 88, 89, 96, 98, 99, 101 AND 117-123

Each of Claims 2-4, 6, 8, 9, 11, 15, 16, 18, 31-33, 36-37, 39, 41, 43, 44, 46, 50, 51, 53, 66-68, 71-73, 75, 77, 84, 86, 88, 89, 96, 98, 99, 101 and 117-123 depends from Claim 1, 38, or 116, and includes the above-quoted features of its parent claim by dependency. Thus, the cited references also fail to teach or suggest at least one feature found in Claims 2-4, 6, 8, 9, 11, 15, 16, 18, 31-33, 36-37, 39, 41, 43, 44, 46, 50, 51, 53, 66-68, 71-73, 75, 77, 84, 86, 88, 89, 96, 98, 99, 101 and 117-123. Therefore, the cited references do not render obvious Claims 2-4, 6, 8, 9, 11, 15, 16, 18, 31-33, 36-37, 39, 41, 43, 44, 46, 50, 51, 53, 66-68, 71-73, 75, 77, 84, 86, 88, 89, 96, 98, 99, 101 and 117-123. Reconsideration of the rejection is respectfully requested.

In addition, Claims 2-4, 6, 8, 9, 11, 15, 16, 18, 31-33, 36-37, 39, 41, 43, 44, 46, 50, 51, 53, 66-68, 71-73, 75, 77, 84, 86, 88, 89, 96, 98, 99, 101 and 117-123 recite one or more additional features that independently render their respective claims patentable. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 2-4, 6, 8, 9, 11, 15, 16, 18, 31-33, 36-37, 39, 41, 43, 44, 46, 50, 51, 53, 66-68, 71-73, 75, 77, 84, 86, 88, 89, 96, 98, 99, 101 and 117-123 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

B. Mehta, Leveridge and Malik.

Claims 7, 42, 76 and 87 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Mehta, Leveridge* and in view of U.S. Patent No. 6,873,691 (hereinafter *Malik*). The rejection is respectfully traversed.

Each of Claims 7, 42, 76 and 87 is dependent upon independent Claim 1 or 38. As discussed in section A above, the combination of *Mehta* and *Leveridge* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Mehta* and *Leveridge*, are also missing from *Malik*. In fact, the Office Action did not rely upon *Malik* for teaching the one or more features. Consequently, the combination of *Mehta*, *Leveridge*, and *Malik* fails to teach or suggest one or more features of Claims 7, 42, 76 and 87. Thus, Claims 7, 42, 76 and 87 are patentable over the combination of *Mehta*, *Leveridge*, and *Malik*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Mehta*, *Leveridge*, and *Malik*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 7, 42, 76 and 87 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

C. Mehta, Leveridge and Clarke.

Claims 25 and 60 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Mehta* and *Leveridge* in view of U.S. Patent No. 5,502,636 (hereinafter *Clarke*). The rejection is respectfully traversed.

Each of Claims 25 and 60 is dependent upon independent Claim 1 or 38. As discussed in section A above, the combination of *Mehta* and *Leveridge* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Mehta* and *Leveridge*, are also missing from *Clarke*. In fact, the Office Action did not rely upon *Clarke* for teaching the one or more features. Consequently, the combination of *Mehta*, *Leveridge*, and *Clarke* fails to teach or suggest one or more features of Claims 25 and 60. Thus, Claims 25 and 60 are patentable over the combination of *Mehta*, *Leveridge*, and *Clarke*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Mehta*, *Leveridge*, and *Clarke*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 25 and 60 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

D. Mehta and Hahn.

Claims 29, 30, 64 and 65 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Mehta* and *Leveridge*, further in view of U.S. Patent No. 6,704,612 (hereinafter *Hahn*). The rejection is respectfully traversed.

Each of Claims 29, 30, 64 and 65 is dependent upon independent Claim 1 or 38. As discussed in section A above, the combination of *Mehta* and *Leveridge* fails to teach or suggest one or more features of Claims 1 and 38. As discussed, the one or more features, identified above, which are missing from the combination of *Mehta* and *Leveridge*, are also missing from *Hahn*. Consequently, the combination of *Mehta*, *Leveridge*, and *Hahn* fails to teach or suggest one or more features of Claims 29, 30, 64 and 65. Thus, Claims 29, 30, 64 and 65 are patentable over the combination of *Mehta*, *Leveridge*, and *Hahn*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Mehta*, *Leveridge*, and *Hahn*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 29, 30, 64 and 65 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

E. Mehta, Leveridge and Kawecki.

Claims 74 and 85 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Mehta*, *Leveridge* and in further view of U.S. Patent No. 5,963,625 (*Kawecki*). The rejection is respectfully traversed.

Each of Claims 74 and 85 is dependent upon independent Claim 1 or 38. As discussed in section A above, the combination of *Mehta* and *Leveridge* fails to teach or suggest one or more features of Claims 1 and 38. As discussed, the one or more features, identified above, which are missing from the combination of *Mehta* and *Leveridge*, are also missing from *Kawecki*. Consequently, the combination of *Mehta*, *Leveridge*, and *Kawecki* fails to teach or suggest one or more features of Claims 74 and 85. Thus, Claims 74 and 85 are patentable over the combination of *Mehta*, *Leveridge*, and *Kawecki*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Mehta*, *Leveridge*, and *Kawecki*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 74 and 85 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

V. CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
HICKMAN PALERMO TRUONG & BECKER
LLP

Date: September 8, 2010

/KarlTRees#58983/

Karl T. Rees, Reg. No. 58,983

2055 Gateway Place, Suite 550
San Jose, CA 95110
(408) 414-1233
Facsimile: (408) 414-1076